

REMARKS/ARGUMENTS

Claims 19-21 and 26-30 have been canceled pursuant to the Restriction Requirement that has been made final.

Claims 22-25, 31-36 were rejected under 35 U.S.C. §102(e) as being anticipated by Frong et al (US 6,372,376 B1). In support of the rejection, the Examiner stated:

With respect to claims 22,24, Frong et al. teach a method of making a current collector for a fuel cell comprising coating a metal substrate with a layer of protective coating. The coating comprises a mixture of electrically conductive particles dispersed throughout an oxidant-resistant and acid-resistant, water-insoluble polymeric matrix. The mixture comprises graphite particles (filler) and other electrically conductive particles selected from the group consisting of gold and carbon (particle). The mix is applied to the [substrate] followed by drying and curing of the coating. See Column 6, Lines 1-51, Claim 1.

However, the rejection makes no analysis with respect to where the numerous limitations of independent claim 22 are found in Frong et al. To help clarify Applicants' claimed invention, minor amendments have been made to independent claim 22. Notwithstanding those minor amendments, the rejection of claim 22 ignores numerous claim limitations and is therefore improper. For example, the rejection ignores the recitation "coating an electrically conductive substrate with a tacky layer of uncured or undried material comprising a corrosion-proof, electrically-conductive filler dispersed throughout an oxidation-resistant and acid-resistant polymer" and "embedding a plurality of electrically-conductive particles in a surface of said layer" and "so as to increase the conductivity of said surface over the conductivity of the remainder of said material" and "curing or drying said layer." Frong et al simply does not identically disclose or suggest such a method. No prima facie case of anticipation has been established.

With respect to claims 23,34, the Examiner has taken the position that Frong et al teach the coating can be applied by spraying the particles onto the substrate, citing Column 5, Lines

21-23. However, Column 5, Lines 21-23 state that the coating may be applied by a variety of methods including spraying but does not disclose or suggest that the particles should be sprayed onto the substrate as maintained by the Examiner. And even if Fronk et al did identically disclose or suggest the same, Applicants' claim recites "spraying said particles on said surface." The "surface" referred to in independent claim 22 is the surface of the tacky layer of uncured or undried material.

The Examiner also takes the position that Fronk et al does not disclose the spraying pressure "of the coating" but maintains such is inherent. Again, Applicants' claim 23 calls for spraying particles, not the coating. Furthermore, the Examiner's position with respect to inherency is completely misplaced. Because the Examiner cannot find a claim limitation in the prior art, the Examiner cannot simply state that such is inherent. In order for the principal of inherency to be appropriately applied, following the reference must necessarily produce the claimed invention. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd.Pat.App.&Inter.1990). MPEP 2112. The Examiner has provided no rationale or explanation why following the reference would necessarily produce the specific act recited in claim 23 of "spraying the particles on said surface" of the tacky layer of uncured or undried material. Claim 34 includes similar language as claim 22, and is patentable on the same basis. No prima facie case of anticipation has been established with respect to claims 23,34.

With respect to claim 25,31,32, each depends from independent claim 22 and is believed to be patentable under the same basis.

With respect to claim 33, the Examiner has taken the position that Fronk et al does not disclose the concentration of the particles present in the composite coating however, that such characteristics would have been inherent given that Fronk et al and the present application utilizes the same spraying method to apply the coating. Again, when the Examiner cannot find called for limitations in the claims, the Examiner cannot simply state that such missing

limitations are inherent without providing some evidence that following the reference would necessarily produce the claimed invention. That is, following the reference must produce the claimed invention. Again, Fronk et al does not identically disclose or suggest embedding particles in a surface of a tacky layer of uncured and undried material which already includes a conductive filler. Claim 33 requires that the embedding of the particles are such that the particles are present in a higher concentration in the surface than the remainder of the composite. Fronk et al simply does not identically disclose or suggest the same. No prima facie case of anticipation of claim 33 has been established.

CONCLUSION

In view of the above amendments and remarks, Applicant respectfully requests reconsideration and allowance of all the claims now in the case.

The Examiner is invited to telephone the Applicant's undersigned attorney at 248-689-3500 if any unresolved matters remain.

Any needed extension of time is hereby requested with the filing of this document. The Commissioner is authorized to charge the fees associated with this request, and to charge any additional fees or credit any overpayment to Deposit Account No. 07-0960 (General Motors). A duplicate copy of this letter is enclosed herewith.

The undersigned is an attorney of record.

Respectfully submitted,

Reising Ethington Barnes Kisselle PC
PO Box 4390
Troy, Michigan 48099-4390
Telephone: 248-689-3500
Facsimile: 248-689-4071
Email: brooks@reising.com

by 
CARY W. BROOKS
Registration No. 33,361

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